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1 UNITED STATES PATENT AND TRADEMARK OFFICE  
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4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
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8 *Ex parte* DANIELA GIACCHETTI, GILLES RUBINSTENN,  
9 and FRANCIS PRUCHE  
10

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11  
12 Appeal 2007-2841  
13 Application 10/024,620  
14 Technology Center 3600  
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16  
17 Decided: April 7, 2008  
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19  
20 Before MURRIEL E. CRAWFORD, LINDA E. HORNER, and  
21 ANTON W. FETTING, *Administrative Patent Judges*.  
22 FETTING, *Administrative Patent Judge*.

23 DECISION ON APPEAL

24 STATEMENT OF CASE

25 Daniela Giacchetti, Gilles Rubinstenn, and Francis Pruche (Appellants) seek  
26 review under 35 U.S.C. § 134 of a final rejection of claims 1-48, the only claims  
27 pending in the application on appeal.

28 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

We AFFIRM.

The Appellants invented a way of providing beauty analysis and guidance in response to information about a subject's characteristics through a series of queries. The subject participates in an interactive beauty analysis with a virtual beauty consultant presented to the subject visually and/or audibly, who may query the subject. Information reflective of responses may be incorporated into subsequent queries. The virtual consultant also may provide beauty guidance to the subject based on the responses to queries (Specification 3-4:¶s 007-008).

An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below [bracketed matter and some paragraphing added].

1. An electronic beauty analysis method, comprising:

[1] maintaining beauty information in a data structure;

[2] receiving personal information about a subject;

[3] selecting for presentation to the subject at least some beauty information maintained in the data structure based on the received information;

[4] presenting to the subject an image of a virtual beauty consultant;  
and

[5] causing the image of the consultant to present to the subject the beauty information selected for presentation.

This appeal arises from the Examiner's Final Rejection, mailed December 1, 2004. The Appellants filed an Appeal Brief in support of the appeal on October 3, 2005. An Examiner's Answer to the Appeal Brief was mailed on February 1, 2007.

PRIOR ART

The Examiner relies upon the following prior art:

Rosenblatt	US 2002/0007276 A1	Jan. 17, 2002
Maloney	WO 01/18674 A2	Mar. 15, 2001

REJECTION

Claims 1-48 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Maloney and Rosenblatt.

ISSUES

The issue pertinent to this appeal is whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 1-48 under 35 U.S.C. § 103(a) as unpatentable over Maloney and Rosenblatt. The pertinent issue turns on whether Maloney and Rosenblatt would render the claimed virtual beauty consultant obvious.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

*Maloney*

01. Maloney is directed to providing a customized product combination to a consumer. It collects profiling data about a consumer, determines a category, and provides the consumer with a list of one or more products that correspond to the consumer profiling category. A product choice selected from the list is received from the consumer. The consumer is

provided a customized product which corresponds to the consumer profiling data and the selected product choice (Maloney 3:Fourth ¶).

02. Maloney obtains psychological and physiological information of a consumer and creates a personalized profile from the attitudinal and physiological information with a customized user interface corresponding to the personalized profile of the consumer. The interface correlates the psychological and physiological information of the consumer. Maloney provides the consumer with a list of interaction options which correlate to the personalized profile of the consumer. The consumer chooses an option and is surveyed for further feedback data used to modify the personalized profile and the customized user interface (Maloney 3:Fifth ¶).

03. Maloney's invention responds to women's preference to choose beauty care products on a one-to-one (in person, with the assistance of an experienced consultant) basis. Information on color shade, oiliness and other physiological properties of the skin and hair are vital to providing an effective cosmetic facial product. In addition, certain environmental conditions can affect the performance of the products. On the other hand, some women prefer to purchase their beauty care products without the assistance of others. For example, the consumer may be embarrassed to discuss with another person available product options which may overcome a specific physiological condition or concern of the consumer. At the same time, the consumer desires a level of customer service which is tailored to her preferences and purchasing feedback. Prior to Maloney, there was a limited ability for a consumer

1 to shop for customized beauty products on her own and with  
2 individualized guidance (Maloney 2:First and second full ¶'s).

3 04. Maloney's user interface may provide audio interaction and response,  
4 with the consumer interacting with the user interface through a  
5 microphone and speakers (Maloney 20:Last ¶).

6 05. Maloney may display an image of the consumer. The consumer can  
7 make product selections and the virtual results are displayed on the  
8 image of the consumer to depict how the products will look on the  
9 consumer to help define the consumer's preferred look. The consumer  
10 alters the image to produce the desired look and then is provided with a  
11 list of products which should achieve the desired look (Maloney 20:Last  
12 ¶).

13 06. After a customized product has been provided to the consumer,  
14 feedback data is requested from the consumer via voice communication,  
15 direct mail, electronic mail and additional web pages requesting  
16 feedback on the web site. The feedback data is processed by a neural  
17 network, which suggests changes to the consumer profiling algorithms  
18 and customized user interface (Maloney 22:Second full ¶).

*Rosenblatt*

07. Rosenblatt is directed to photo-realistic, three-dimensional computer animations, also referred to as "virtual representatives," in a variety of business and communications settings (Rosenblatt ¶ 0007).
08. These settings include customer-support applications for web retailers or service providers, as well as interpersonal email and chat. The use of a standard architecture for these virtual representatives and to animate them enables the customization of the representatives according to the needs or desires of individual users and the deployment of their use for a variety of business and interpersonal communications applications (Rosenblatt ¶ 0007).
09. Rosenblatt applies its virtual representatives to traditional forms of customer support for Web-based retailers including Frequently Asked Questions (FAQs), detailed instructions, and indexed and searchable help databases (Rosenblatt ¶ 0005). Such FAQs and help databases are data structures that store queries and responses to typical user questions.
10. Various levels of control over the appearance and performance of the virtual representatives may be implemented. For instance, a user may choose one of a selected set of standard virtual representatives, and incorporate certain standard expressions into text to be voiced by the selected virtual representative (Rosenblatt ¶ 0008).
11. Rosenblatt's authoring module may include recorded voice and key-framed data for animating the virtual representative on a frame-by-frame basis or voice and meta-data for animating the virtual representative, where the meta-data contains commands such as "happy" which then

1 gets translated into a happy looking face at the appropriate time  
2 (Rosenblatt ¶ 0015).

3 12. In order to generate virtual representatives having realistic response  
4 characteristics, a computer model of a performer's face is created using  
5 an optical scanning system. Still photographs are then used to acquire  
6 various textures. A "performance" is then acquired using a data motion  
7 capture system in real time, followed by video digitization and tracking  
8 analysis using the modeling techniques described above. A series of  
9 node coordinates are then generated that track material features as they  
10 move in time. This results in acquiring even the most subtle change in  
11 facial geometry as the performer goes through a series of motions and  
12 expressions (Rosenblatt ¶ 0040).

13 13. Rosenblatt provides a standard platform for using three-dimensional,  
14 photo-realistic virtual representatives for use as guides, corporate  
15 spokespersons, teachers, entertainers, game characters, personal avatars,  
16 advertising personalities, and individual sales help. Applications for  
17 these virtual representatives include email, Web pages, instant  
18 messaging, chatrooms, training, product support, human resources,  
19 supply chain software, ISPs, ASPs, distance learning, bill presentment,  
20 and PC gaming, among others (Rosenblatt ¶ 0041).

21 14. Rosenblatt shows an image of a computer screen with multiple virtual  
22 people present on the same screen interacting through facemail  
23 (Rosenblatt Fig. 1).



*Facts Related To The Level Of Skill In The Art*

15. Neither the Examiner nor the Appellants has addressed the level of ordinary skill in the pertinent arts of tracking items and data formatting. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

*Facts Related To Secondary Considerations*

16. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

*Claim Construction*

During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004).

Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003) (claims must be interpreted “in view of the specification” without importing limitations from the specification into the claims unnecessarily)

Although a patent applicant is entitled to be his or her own lexicographer of patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*, 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing such definitions in the Specification with sufficient clarity to provide a person of ordinary skill in the art with clear and precise notice of the meaning that is to be construed. *See also In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (although an inventor is free to define the specific terms used to describe the invention, this must be done with reasonable clarity, deliberateness, and precision; where an inventor chooses to give terms uncommon meanings, the inventor must set out any uncommon definition in some manner within the patent disclosure so as to give one of ordinary skill in the art notice of the change).

*Obviousness*

A claimed invention is unpatentable if the differences between it and the prior art are “such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.” 35 U.S.C. § 103(a) (2000); *KSR Int’l v. Teleflex Inc.*, 127 S.Ct. 1727 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

In *Graham*, the Court held that that the obviousness analysis is bottomed on several basic factual inquiries: “[1] the scope and content of the prior art are to be determined; [2] differences between the prior art and the claims at issue are to be ascertained; and [3] the level of ordinary skill in the pertinent art resolved.” 383 U.S. at 17. *See also KSR Int’l v. Teleflex Inc.*, 127 S.Ct. at 1734. “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR*, at 1739.

“When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a

different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.” *Id.* at 1740.

“For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.” *Id.*

“Under the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed.” *Id.* at 1742.

#### ANALYSIS

*Claims 1-48 rejected under 35 U.S.C. § 103(a) as unpatentable over Maloney and Rosenblatt.*

#### *Claims 1-14 and 16-19*

The Appellants argue claims 1-14 and 16-19 as a group.

Accordingly, we select claim 1 as representative of the group.  
37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Examiner found that Maloney described all of the steps in claim 1 in providing beauty advice, but did not specifically apply them to a virtual beauty consultant. To overcome this deficiency, the Examiner found that Rosenblatt described virtual representatives and implicitly found that one of ordinary skill would have known that such a representative within Maloney’s beauty advice environment would have been a virtual beauty consultant, and concluded it would have been obvious to a person of ordinary skill in the art to have therefore applied Rosenblatt to Maloney (Answer 4-5).

1       The Appellants contend that both Maloney and Rosenblatt fail to describe a  
2       virtual beauty consultant (Br. 13:Last ¶); that one of ordinary skill would not have  
3       combined Maloney and Rosenblatt (Br. 14:Last ¶); that replacing Maloney's  
4       customer image with Rosenblatt's personal representative would make Maloney  
5       unsuitable (Br. 16:Last ¶); and that the Examiner failed to show motivation in the  
6       references for combining the references (Br. 17:Second ¶).

7       We disagree. Rosenblatt is directed to photo-realistic, three-dimensional  
8       computer animations, also referred to as "virtual representatives," in a variety of  
9       business and communications settings [FF 07]. Rosenblatt provides virtual  
10      representatives for use as guides, corporate spokespersons, teachers, entertainers,  
11      personal avatars, and individual sales help [FF 13]. Maloney is directed to  
12      providing sales assistance to customers in general [FF 01] and to beauty product  
13      customers in particular by providing a level of customer service which is tailored  
14      to the customer preferences and purchasing feedback [FF 03].

15      We find that Maloney's beauty products are a predictable species of  
16      Rosenblatt's business and communications settings, and that a virtual beauty  
17      consultant would be a predictable species of Rosenblatt's virtual teacher and sales  
18      help representatives within Maloney's beauty care environment. The Appellants'  
19      do not persuade us of error on the part of the Examiner because the Appellants  
20      respond to the rejection by attacking the references separately, even though the  
21      rejection is based on the combined teachings of the references. Non-obviousness  
22      cannot be established by attacking the references individually when the rejection is  
23      predicated upon a combination of prior art disclosures. *See In re Merck & Co.*  
24      *Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

As to the arguments that the references are not combinable and there being no motivation to combine, we find that Rosenblatt's taught rationale for its virtual representatives for customer support [FF 09] would have suggested its application to such specific customer support environments as Maloney's [FF 03]. We find that the Appellants' argument that replacing Maloney's customer image with Rosenblatt's personal representative would make Maloney unsuitable simply presents us with a false choice, as no one, and certainly not one of ordinary skill, would consider such a substitution. Rosenblatt's virtual representatives present information to the customer. Such presentation of information to a beauty care customer is described by Maloney. We find that one of ordinary skill would have applied Rosenblatt's virtual representatives to Maloney's presentation of information, which would be consistent with Maloney's operation.

*Claim 15*

Claim 15 requires causing a pre-recorded image of an actual human being to be displayed to the subject. The Examiner found that Maloney described the added limitations (Answer 7). The Appellants repeat their contentions from claim 1, which we find equally unpersuasive here, and further contend that Rosenblatt's creating geometry for an image does not constitute causing a pre-recorded image of an actual human being to be displayed (Br. 20:Top ¶¶).

We disagree. Rosenblatt uses photo-realistic images [FF 07] and optically scans pictures of actual performers to create such images [FF 12]. The Appellant appears to be arguing that applying geometric transformations to the image for animation purposes negates the images being an image of an actual human being. Nothing in claim 15 precludes post-processing of the actual human being image. Indeed, if it did, it would be impossible to meet the limitations of claim 15,

1 because any representation of an image using finite resources, such as computer  
2 memory, will inherently degrade the actual appearance of the subject. Therefore,  
3 Rosenblatt's application of processing for animation does not negate the property  
4 of the image being that of an actual human being.

5 *Claims 20-21*

6 The Appellants argue claims 20-21 as a group. Accordingly, we select claim  
7 20 as representative of the group. Claim 20 requires presenting an image of a  
8 virtual user receiving the beauty information. The Examiner found that Maloney  
9 described the added image limitations and Rosenblatt described the virtual user  
10 limitations (Answer 8). The Appellants contend that although Maloney describes  
11 providing a customer with information and displaying an image of a customer,  
12 Maloney does not describe an image of a virtual user receiving beauty information  
13 (Br. 21:First ¶) and that Rosenblatt fails to show a virtual customer (Br. 21:Second  
14 ¶). The Appellants also repeat the contention from claim 1 that replacing  
15 Maloney's customer image with Rosenblatt's personal representative would make  
16 Maloney unsuitable and that there was no motivation to combine the references.

17 We disagree. As to the last contentions, we find, as we did in claim 1, *supra*,  
18 that no such substitution is suggested or proposed, and that Rosenblatt's virtual  
19 representative suggests its usage in a customer support position such as Maloney's.  
20 As to the virtual user, the Appellants admit (Br. 21:First full ¶) that Maloney  
21 describes displaying virtual results in an image of a customer [FF 05]. We find  
22 that Rosenblatt suggests animating an image of the computer user for the purpose  
23 of interpersonal chat [FF 08] with Rosenblatt's virtual representative [FF07]. We  
24 further find that one of ordinary skill would have found having multiple virtual  
25 people, including a virtual representation of the user, present on a screen to be a

predictable use of Rosenblatt in view of Rosenblatt's application towards chatrooms, PC gaming, and personal avatars [FF 13] all of which suggest visible representation of interaction within the computer environment between the user and another party and Rosenblatt's explicit portrayal of such an interaction between multiple virtual people [FF 14].

*Claims 44-46*

The Appellants argue claims 44-46 as a group. Accordingly, we select claim 44 as representative of the group. Claim 44 requires automatically selecting an image of the virtual beauty consultant based on characteristics of the subject. The Examiner found that Maloney described the added limitations (Answer 9). The Appellants contend that neither reference suggests automatically selecting an image of a consultant (Br. 25).

We disagree. As the Appellants admit (Br. 25:First full ¶), Rosenblatt describes selecting an image of the virtual beauty consultant (FF 10). Since the user makes the selection, the user must be basing these selections on the characteristics of importance to the user; it is the user's selection after all. The only issue is whether doing so automatically would have been obvious. Automation of a known manual step is generally obvious. *See Leapfrog*, 485 F.3d at 1163. Maloney obtains psychological and physiological information of a consumer and creates a personalized profile from the attitudinal and physiological information with a customized user interface corresponding to the personalized profile of the consumer. The interface includes customized information pages to correlate the psychological and physiological information of the consumer [FF 02]. The use of such psychological and physiological information to create a personalized profile with a customized user interface, where the interface would

include a virtual representative as suggested by Rosenblatt, would have suggested using this information to automatically customize even the virtual representative aspect of the interface.

*Claim 47*

Claim 47 requires presenting the image of the virtual beauty consultant in a customizable environment. The Examiner found that Maloney described the added limitations (Answer 9). The Appellants contend that neither reference describes presenting in a customized environment (Br. 26:Bottom ¶ - 27:Top ¶).

We disagree. As the Appellants admit (Br. 26:Bottom ¶) Maloney describes customizing the interface [FF 02]. Further, Rosenblatt describes its virtual representatives in a variety of environments, such as instant messaging, chatrooms, training, product support, human resources, supply chain software, ISPs, ASPs, distance learning, bill presentment, and PC gaming [FF 13]. The claim makes no limitation on the nature of the environment so customized. We find that the combination of Maloney's customizable interface, of which Rosenblatt's virtual representative would be a part, with Rosenblatt's selection of environments in which to place virtual representatives would have suggested to one of ordinary skill presenting the image of the virtual beauty consultant in a customizable environment.

*Claim 48*

Claim 48 requires the personification of the subject receiving selected information from the virtual beauty consultant and is thus essentially the same as claim 20. The Examiner found that Maloney described the added limitations (Answer 9). The Appellants repeated the arguments made for claim 20, and we find that they are equally unpersuasive here for the same reasons we found, *supra*.



*Claims 22-25 and 27-30*

The Appellants argue claims 22-25 and 27-30 as a group.

Accordingly, we select claim 22 as representative of the group.

Claim 22 requires storing a series of beauty related queries in a data structure; establishing an interface enabling a subject to participate in an interactive beauty analysis; presenting to the subject a human image; and causing the human image to appear as audibly presenting to the subject at least one of the queries from the data structure.

The Examiner found that Maloney described all of the steps in claim 22 in providing beauty advice, but did not specifically apply them to a human image audibly resending the information. To overcome this deficiency, the Examiner found that Rosenblatt described a human image audibly representing the information and implicitly found that one of ordinary skill would have known that such an audible image within Maloney's beauty advice environment would have provided beauty information, and concluded it would have been obvious to a person of ordinary skill in the art to have applied Rosenblatt to Maloney (Answer 5-6). The Appellants contend that neither Maloney nor Rosenblatt appears to audibly represent a query from a data structure (Br. 28:Bottom ¶ - 29:First full ¶).

We disagree. Rosenblatt specifically recites the application of its customer service as being applied to Frequently Asked Questions (FAQs), detailed instructions, and indexed and searchable help databases [FF 09]. We find that FAQs and help databases are databases that store queries typically presented by users [FF 09]. Since Rosenblatt audibly presents its information with the animated virtual representative [FF 11], and the information is contained in a data structure that contains queries typically made by users, Rosenblatt describes causing a

human image to appear as audibly presenting to the subject queries from a data structure.

The Appellants also repeat the contention that there is no motivation to apply Rosenblatt to Maloney, which we find unpersuasive for the same reasons we found in claim 1, *supra*.

*Claim 26*

Claim 26 combines claims 22 and 15. The Appellants repeat the contentions from those claims which we find unpersuasive for the same reasons we found *supra*.

*Claims 31 and 32*

The Appellants argue claims 31 and 32 as a group. Accordingly, we select claim 31 as representative of the group. Claim 31 combines claims 22 and 48. The Appellants repeat the contentions from those claims which we find unpersuasive for the same reasons we found *supra*.

*Claims 33-41*

The Appellants argue claims 33-41 as a group. Accordingly, we select claim 33 as representative of the group. Claim 33 is essentially the same as claim 22. The Appellants repeat the contentions from claim 22 which we find unpersuasive for the same reasons we found *supra*.

*Claims 42 and 43*

The Appellants argue claims 42 and 43 as a group. Accordingly, we select claim 42 as representative of the group. Claim 42 requires a second human image to appear to the subject through the terminal in a manner projecting an appearance that the second human image answers a query.

The Examiner found that Rosenblatt described the added limitations (Answer 8). The Appellants contend that neither reference suggests the claimed second human image (Br. 33:Second full ¶). We disagree. We found with respect to claim 20 *supra* that Rosenblatt suggests presenting multiple virtual people in an environment. We also found with respect to claim 22 *supra* that Rosenblatt suggests presenting questions and answers. Thus, having a second person present answers is no more than having each of Rosenblatt's separate virtual people perform each of Rosenblatt's questions and answers. We find that having separate virtual people raise and answer a question is a predictable representation of the real world activity of two people performing the same.

The Appellants have not sustained their burden of showing that the Examiner erred in rejecting claims 1-48 under 35 U.S.C. § 103(a) as unpatentable over Maloney and Rosenblatt.

#### CONCLUSIONS OF LAW

The Appellants have not sustained their burden of showing that the Examiner erred in rejecting claims 1-48 under 35 U.S.C. § 103(a) as unpatentable over the prior art.

On this record, the Appellants are not entitled to a patent containing claims 1-48.

#### DECISION

To summarize, our decision is as follows:

- The rejection of claims 1-48 under 35 U.S.C. § 103(a) as unpatentable over Maloney and Rosenblatt is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

jlb

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